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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,378	01/16/2001	Teiji Mizutani	892_014	5329
25191	7590	03/31/2004	EXAMINER	
BURR & BROWN PO BOX 7068 SYRACUSE, NY 13261-7068			GRAVINI, STEPHEN MICHAEL	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/761,378

Applicant(s)

MIZUTANI, TEIJI

Examiner

Stephen M Gravini

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/8-5-02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Specification

The specification is objected to because it contains several embedded hyperlinks and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlinks and/or other form of browser-executable code. See MPEP § 608.01. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts".

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See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete, and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998). Together, the "technological arts" and "useful, concrete, and tangible result" judicial review standard, result in a comprehensive examination standard wherein the "technological arts" is one element and the "useful, concrete, and tangible result" is another complementary element.

This comprehensive examination standard was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the

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court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these

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analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. The Board of Patent Appeals and Interferences (BPAI) have recently acknowledged this dichotomy in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BPAI 2001).

Claims 7-11 are rejected under 35 U.S.C. 101 because the independently claimed invention does not recite a useful, concrete, and tangible result under *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed Cir. 1998) such that the claimed invention is within the technological arts under *In re Waldbaum* 173 USPQ 430 (CCPA 1972) wherein the phrase "technological arts" is synonymous with "useful arts" as it appears in Article I, Section 8 of the United States Constitution. In these claims, it is considered that a concrete and tangible result within the technological arts is not recited. Specifically, the recitation of controlling a notice of prize information; registering, as applicant information, attributes of applicants who applied for the prize information; creating content data in accordance with the attributes of the applicants in the applicant information; transmitting the content to the corresponding applicant; receiving the applicant information on the attributes of the applicants, and accepting the

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applications for the prize information; wherein the applicant information contains an attribute for representing a relation between a commercial article in a predetermined category and the applicant; acquiring article information on the commercial article in the predetermined category; creating the content data on the basis of the article information of the article information acquired; and creating other set of content data corresponding to the applicant information, wherein the content data contain a piece of information for accessing other set of content data is considered not to produce a useful, concrete, and tangible result within the technological arts because under the *Toma* test, it is not considered that the invention can be carried out by a computer and therefore is not within the bounds of statutory subject matter . Furthermore, under *In re Wamerdam*, 33 F.3d 1354; 31 USPQ2d 1754 (Fed. Cir. 1994), the controlling a notice of prize information; registering, as applicant information, attributes of applicants who applied for the prize information; creating content data in accordance with the attributes of the applicants in the applicant information; transmitting the content to the corresponding applicant; receiving the applicant information on the attributes of the applicants, and accepting the applications for the prize information; wherein the applicant information contains an attribute for representing a relation between a commercial article in a predetermined category and the applicant; acquiring article information on the commercial article in the predetermined category; creating the content data on the basis of the article information of the article information acquired; and creating other set of content data corresponding to the applicant information, wherein the content data contain a piece of information for accessing other set of content data recitations are considered intangible because those steps are simply an abstract construct, such as a disembodied data structure and a method of making it, wherein those recitations involve more than a manipulation of an abstract idea and therefore is non-statutory under 35

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USC 101. Because the claimed invention does not recite a useful, concrete, and tangible result, such that it is considered not within technological arts so that it uses technology in a non-trivial matter. Finally under *Ex parte* Bowman, 61 USPQ2d 1665 (Bd. Pat. App. & Inter. 2001) (unpublished but cited for analysis rather than precedent), in which an invention disclosed and claimed directed to a human merely making mental computations and manually plotting results on a paper chart is nothing more than an abstract idea which is not tied to any technological art and is not a useful art as contemplated by the United States Constitution. In this independently claimed invention, the steps of controlling a notice of prize information; registering, as applicant information, attributes of applicants who applied for the prize information; creating content data in accordance with the attributes of the applicants in the applicant information; transmitting the content to the corresponding applicant; receiving the applicant information on the attributes of the applicants, and accepting the applications for the prize information; wherein the applicant information contains an attribute for representing a relation between a commercial article in a predetermined category and the applicant; acquiring article information on the commercial article in the predetermined category; creating the content data on the basis of the article information of the article information acquired; and creating other set of content data corresponding to the applicant information, wherein the content data contain a piece of information for accessing other set of content data are considered nothing more than an abstract idea since it is not tied to any technological art. However in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by LaLonde et al. (WO 94/15294). As a premise, the claim recitation “prize information” is treated as a solicitation of information from applicants or users. This interpretation is considered reasonable in light of the prize information descriptions from applicant’s specification. In this case prize information is considered patentably equivalent to the disclosed self-publishing individualized catalog beginning on page 8 of the primary reference because both solicit information from applicants or users. LaLonde discloses the claimed invention comprising:

a notice control module for controlling a notice of a prize information (implied at page 21 beginning at the second full paragraph because the disclosed gift can be interpreted to be patentably synonymous to the claimed prize since both are used to entice a recipient or user or applicant to provide information);

a registration control module for registering, as applicant information, attributes of applicants who applied for the prize information (page 22 line 1 wherein the disclosed virtual registration card is considered patentably equivalent to the claimed registration control module);

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a content data creating module for creating content data in accordance with the attribute of the applicants in the applicant information (page 23 lines 25-29 wherein the disclosed direct connect options are considered patentably equivalent to the claimed content data creating module because both create data in accordance with the attribute of the applicants in the applicant information); and

a transmitting module for transmitting the content data to the corresponding applicant (page 24 lines 29-31 wherein the disclosed agent mail, fax, or phone notification is considered patentably synonymous to the claimed transmitting module). LaLonde is considered to also disclose the claimed application accept module (page 23 lines 10-11), storage module (page 22 line 15), applicant commercial article relation attribute (page 22 line 37 wherein the disclosed similar properties established the claimed applicant commercial article relation attribute because both are types of consumer profiling), content data creating module based on information acquired (page 22 lines 25-26 because the disclosed agent consumer notification bases the notification on information acquired), and accessing other set of content data (page 23 line 1 wherein the disclosed comparable items is considered patentably equivalent to other content data).

Claims 7-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Rogers et al. (US 5,978,774). As a premise, the claim recitation "prize information" is treated as a solicitation of information from applicants or users. This interpretation is considered reasonable in light of the prize information descriptions from applicant's specification. In

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this case prize information is considered patentably equivalent to the disclosed electronic registration taught in the brief invention summary of the primary reference because both solicit information from applicants or users. Rogers discloses the claimed invention comprising the steps of:

controlling a notice of prize information (column 4 lines 53-63 wherein the claimed notice control is considered performed when the disclosed customer initiates an electronic registration process);

registering, as applicant information, attributes of applicants who applied for the prize information (again column 4 lines 53-63 wherein the disclosed electronic registration performs the claimed registering);

creating content data in accordance with the attributes of the applicants in the applicant information (column 6 lines 2-5 wherein the disclosed database inclusion indications are considered patentably equivalent to the claimed content data creation because both are considered to create content in accordance with the attributes of the applicants in the applicant information, in this case the disclosed store associate serves as the claimed applicant);

transmitting the content to the corresponding applicant (column 6 lines 6-13 wherein the disclosed printed receipt is considered to anticipate the claimed transmission). Rogers is considered to also disclose the claimed receiving the applicant information on the attributes of the applicants (column 6 lines 12-13), wherein the applicant information contains an attribute for representing a relation between a commercial article in a predetermined category and the applicant (column 6 lines 14-

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22), acquiring article information on the commercial article in the predetermined category (column 6 lines 23-33), creating the content data on the basis of the article information of the article information acquired (column 6 lines 42-52), and creating other set of content data corresponding to the applicant information, wherein the content data contain a piece of information for accessing other set of content data (column 6 lines 53-65).


Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Von Kohorn (US 5,227,874), Storch et al. (US 5,367,148), Suliman, Jr. et al. (US 2001/0053980), LaLonde et al. (WO 94/15294), and non patent literature The Auto 'Boom' are considered to teach a prize-type registration system and method for acquiring content and applicant information.

Conclusion

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is either steve.gravini@uspto.gov or stephen.gravini@uspto.gov. Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicants choose to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.** Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The Official Fax Numbers for TC-3600 are:

After-final	(703) 872-9327
Official	(703) 872-9306
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**STEPHEN GRAVINI
PRIMARY EXAMINER**

smg
March 25, 2004